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09/753,360	12/29/2000	Gene Ma	2705-134	9717

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EXAMINER

KADING, JOSHUA A

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,360

Applicant(s)

MA, GENE

Examiner

Joshua Kading

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-16, 18, 19, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 17, 20, and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement filed 14 September 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### *Claim Objections*

Claims 1 and 2 are objected to because of the following informalities:

Claim 1, line 5 states "a protocol over said connection that provides..." Because a protocol is something that cannot necessarily be claimed, the beginning of claim 1, line 5 should be changed as follows: --said connection provides supplemental services messaging between the gatekeeper and the intelligent peripheral in accordance with a protocol, said protocol...--

Claim 2, lines 1-2 state "further enables the selective insertion..." This should be changed to --further enables a selective insertion...-- The reason is because the independent claim 1 does not disclose "the selective insertion of one or more messages to the gatekeeper."

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5           Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

          Claim 4 recites the limitation "wherein such selective insertion of one or more messages to the gatekeeper..." in lines 1-2. There is insufficient antecedent basis for  
10   this limitation in the claim. The "insertion of one or more messages to the gatekeeper" is not disclosed in claim 4 or the independent claim 1.

***Claim Rejections - 35 USC § 102***

          The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
15   form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

          (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent  
20   granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

25           Claims 1, 2, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Baxley et al. (U.S. Patent 6,646,997 B1).

          Regarding claim 1, Baxley discloses "telecommunications apparatus between a voice frame network gatekeeper and an intelligent peripheral, the apparatus comprising:

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a voice frame network connection for coupling a gatekeeper to an intelligent peripheral (figure 1, where element 150 is the gatekeeper and element 180 is the intelligent peripheral), and

said connection provides supplemental services messaging between the  
5 gatekeeper and the intelligent peripheral [in accordance with a protocol], said protocol enabling the gatekeeper to selectively insert one or more messages to the intelligent peripheral and to selectively intercept one or more messages from the intelligent peripheral (col. 8, lines 33-40 whereby obtaining additional information for an endpoint means that the gatekeeper is receiving information from the IVR via a request to the  
10 IVR)."

Regarding claim 2, Baxley discloses "the apparatus of claim 1, wherein said protocol further enables the selective insertion of one or more messages to the gatekeeper (col. 8, lines 33-40 where the gatekeeper is again sending messages to the  
15 IVR requesting additional information)."

Regarding claim 8, Baxley discloses "telecommunications apparatus for coordinating a voice frame network gatekeeper and an interactive voice response unit including a performance mechanism for performing a defined task responsive to the  
20 gatekeeper, the apparatus comprising:

a voice frame network connection for coupling a gatekeeper to an interactive voice response unit (figure 1, where element 150 is the gatekeeper and element 180 is the intelligent peripheral);

an invocation mechanism within the gatekeeper for setting a defined task to the  
5 interactive voice response unit via in-band signaling (figure 1, element 150 where the "invocation mechanism" in the gatekeeper is in communication with the IVR as can be read in col. 8, lines 24-28; it should be noted that it is known in the art that IP networks (as mentioned in col. 3, lines 45-47) use in-band signalling); and

a protocol enforcing processor that provides supplemental services messaging  
10 between the gatekeeper and the intelligent peripheral over said interface processor (figure 1, element 150 where it is known that the gatekeeper has a processor in it that is enforced by a protocol), said enabling the gatekeeper to selectively insert one or more messages to the interactive voice response unit and to selectively intercept one or more messages from the interactive voice response unit (col. 8, lines 33-40 whereby  
15 obtaining additional information for an endpoint means that the gatekeeper is receiving information from the IVR via a request to the IVR)."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
20 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.  
25

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxley et al.

5

Regarding claim 9, Baxley discloses the apparatus of claim 8. However, Baxley lacks "said invocation mechanism and said performance mechanism comply with International ITU-T H.323 and H.450 standards." Although Baxley lacks the explicitly disclosure of the H.323 and H.450 standards, it would have been obvious to include these standards with the apparatus of claim 8 as a matter of design choice. The motivation being that a decision to use a particular standard over another in a communication network is entirely dictated by the design of the network, thus a standard incompatible with the network would not be used.

15 Regarding claim 10, Baxley discloses the apparatus of claim 9. Although Baxley lacks the H.323 and H.450 standard, Baxley further discloses "said processor further enables selective insertion of one or more messages to the gatekeeper (col. 8, lines 33-40 where the gatekeeper is again sending messages to the IVR requesting additional information)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the selective insertion of messages to the gatekeeper with the apparatus of claim 9 for the same reasons and motivation as in claim 9.

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Claims 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxley et al. in view of "Call signalling protocols and media stream packetization for packet-based multimedia communication systems" (herein referred to as H.225).

5           Regarding claim 3, Baxley discloses the apparatus of claim 2. However, Baxley lacks what H.225 discloses, that is "wherein such selective insertion of one or more messages to the gatekeeper includes selective insertion of one or more release complete (RELCOM) messages in accordance with the International ITU-T H.323 standard (page 40, section 7.3.9 where the H.225 standard is used in H.323 as is  
10   known in the art; it should also be noted that although Baxley does not explicitly describe a "release" signal for a call, it is obvious that the call must end at some point, and when it does a "release complete" message will be sent)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the "release complete" message in accordance with H.323 with the apparatus of claim 2 for  
15   the purpose of releasing a call after it is finished. The motivation being that an releasing a call that is not being used for a call, is freeing that resource.

          Regarding claims 5 and 11, Baxley discloses the apparatus of claim 1 and claim  
10. However, Baxley lacks what H.225 discloses, that is "wherein such selective  
20   interception includes selective interception of one or more facility (FACILITY) messages in accordance with the International ITU-T H.323 standard (page 47, section 7.4.1 where the routing information provided to the gatekeeper in Baxley is a FACILITY



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message as it defines where the message is going).” It would have been obvious to one with ordinary skill in the art at the time of invention to include the FACILITY message with the apparatus of claim 1 for the purpose of providing information on where a call (message) should be directed. The motivation being that the routing information must  
5 be known in order to complete and maintain a call.

Regarding claim 6, Baxley and H.225 disclose the apparatus of claim 5.

However, Baxley lacks what H.225 further discloses “wherein at least one of the one or more FACILITY messages includes a return results (RETURN RESULTS) component

10 (page 47, section 7.4.1 where the routing information provided to the gatekeeper in Baxley is a FACILITY message as it defines where the message is going, since the routing information is provided to the gatekeeper as in Baxley, it is considered a response or RETURN RESULTS component of a FACILITY message as defined by applicant in the specification, page 6, lines 4-12).” It would have been obvious to one  
15 with ordinary skill in the art at the time of invention to include the RETURN RESULTS message with the apparatus of claim 5 for the same reasons and motivation as in claim 5.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baxley et  
20 al. ('997) in view of Baxley et al. (U.S. Patent 6,657,975 B1).

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Regarding claim 7, Baxley discloses the apparatus of claim 1. However, Baxley ('997) lacks what Baxley ('975) discloses, that is "a service control point operatively connected to the gatekeeper and to a database, said service control point providing information contained in said database to the gatekeeper in response to a query therefrom (figure 1, element 70)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the SCP with the apparatus of claim 1 for the purpose of connecting the circuit switched network to the packet switched network (Baxley '975, col. 4, lines 18-23). The motivation being the SCP allows two different types of networks to communicate with each other.

Claims 14, 15, 16, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxley et al. ('997) in view of Gourraud (U.S. Patent 6,711,156 B1).

Regarding claim 14, Baxley ('997) discloses "a method of interfacing a voice frame network gatekeeper and an interactive voice response unit (IVR) configured as an intelligent peripheral under International H.450 standard with a service control point (SCP), the method comprising:

first conveying requests from the gatekeeper to the IVR over the voice frame network in accordance with a defined protocol (col. 8, lines 33-40 where the gatekeeper is requesting endpoint information from the IVR); and

receiving responses to the requests from the IVR at the gatekeeper over the voice frame network in accordance with a defined protocol, wherein the gatekeeper

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selectively intercepts one or more messages from the IVR (col. 8, lines 33-40 where it is suggested that the gatekeeper's request for endpoint information is answered in some way by the IVR)."

However, Baxley lacks what Gourraud discloses "configuring the gatekeeper as a supplemental services provider (SSP) under International H.450 standard (col. 4, lines 9-15 where the SSP is acting as a gatekeeper, allowing the connections to be setup and exist; it is also noted that H.450 is used with the H.323 standard mentioned in col. 4, line 35)..."

It would have been obvious to one with ordinary skill in the art at the time of invention to include the SSP with the rest of the method for the purpose of setting up appropriate connections between two endpoints. The motivation being that the SSP employs the appropriate services for the connection (Gourraud, col. 4, lines 9-13).

Regarding claim 18, Baxley ('997) discloses "interfacing a voice frame network gatekeeper and an interactive voice response unit (IVR) configured as an intelligent peripheral under International H.450 standard with a service control point (SCP), the method comprising:

first conveying requests from the gatekeeper to the IVR over the voice frame network in accordance with a defined protocol (col. 8, lines 33-40 where the gatekeeper is requesting endpoint information from the IVR); and

receiving responses to the requests from the IVR at the gatekeeper over the voice frame network in accordance with a defined protocol, wherein the gatekeeper

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selectively intercepts one or more messages from the IVR (col. 8, lines 33-40 where it is suggested that the gatekeeper's request for endpoint information is answered in some way by the IVR)."

However, Baxley lacks what Gourraud discloses "configuring the gatekeeper as a supplemental services provider (SSP) under International H.450 standard (col. 4, lines 9-15 where the SSP is acting as a gatekeeper, allowing the connections to be setup and exist; it is also noted that H.450 is used with the H.323 standard mentioned in col. 4, line 35)..."

It would have been obvious to one with ordinary skill in the art at the time of invention to include the SSP with the rest of the method for the purpose of setting up appropriate connections between two endpoints. The motivation being that the SSP employs the appropriate services for the connection (Gourraud, col. 4, lines 9-13).

However, both Baxley and Gourraud lack "a computer-readable medium containing a program" to implement the steps disclosed by Baxley and Gourraud.

Although a computer program is not explicitly disclosed, it would have been obvious to one with ordinary skill in the art at the time of invention to have the computer program implement the steps listed above. The motivation being that a computer program is the only feasible way to efficiently manipulate and control an electronic communication system.

Regarding claim 21, Baxley ('997) discloses "apparatus for interfacing a voice frame network gatekeeper and an interactive voice response unit (IVR) configured as an

intelligent peripheral under the International H.450 standard with a service control point (SCP), the apparatus comprising:

means for first conveying requests from the gatekeeper to the IVR over the voice frame network in accordance with a defined protocol (col. 8, lines 33-40 where the gatekeeper is requesting endpoint information from the IVR)...

means for receiving responses to requests from the IVR at the gatekeeper over the voice frame network in accordance with a defined protocol (col. 8, lines 33-40 where it is suggested that the gatekeeper's request for endpoint information is answered in some way by the IVR)...and

means for selectively intercepting one or more messages from the IVR and for selectively inserting one or more messages to the IVR (col. 8, lines 33-40 where it is suggested that the gatekeeper's request for endpoint information is answered in some way by the IVR)..."

However, Baxley lacks what Gourraud discloses, that is "means for configuring the gatekeeper as a supplemental services provider (SSP) under the International H.450 standard (col. 4, lines 9-15 where the SSP is acting as a gatekeeper, allowing the connections to be setup and exist; it is also noted that H.450 is used with the H.323 standard mentioned in col. 4, line 35)..."

It would have been obvious to one with ordinary skill in the art at the time of invention to include the SSP with the rest of the method for the purpose of setting up appropriate connections between two endpoints. The motivation being that the SSP employs the appropriate services for the connection (Gourraud, col. 4, lines 9-13).

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However, both Baxley and Gourraud lack "a computer-readable medium containing a program" to implement the steps of the apparatus disclosed by Baxley and Gourraud. Although a computer program is not explicitly disclosed, it would have been obvious to one with ordinary skill in the art at the time of invention to have the computer program implement the steps listed above. The motivation being that a computer program is the only feasible way to efficiently manipulate and control an electronic communication system.

Regarding claims 15, 19, and 22, Baxley ('997) and Gourraud disclose the method, computer program, and apparatus of claim 14, claim 18, and claim 21 respectively. However, Baxley lacks what Gourraud further discloses, that is "configuring the IVR as an intelligent peripheral under International H.450 standard (Gourraud, col. 4, lines 9-15 where the SSP is acting as a gatekeeper, and if the IVR is in contact with the gatekeeper as in Baxley, the IVR must be configured using the same standards as the gatekeeper; it is also noted that H.450 is used with the H.323 standard mentioned in col. 4, line 35)..."; and Gourraud lacks what Baxley further discloses, that is "second conveying responses to the requests from the IVR to the gatekeeper over the voice frame network in accordance with a defined protocol (col. 8, lines 33-40 where it is suggested that the gatekeeper's request for endpoint information is answered in some way by the IVR)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the IVR configuration and the sending responses to the gatekeeper from the IVR with the method of claim 14, the computer program of claim

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18, and the apparatus of claim 21 for the same reasons and motivation as in claims 14, 18, and 21.

Regarding claim 16, Baxley ('997) and Gourraud disclose the method of claim

5 14. However, Gourraud lacks what Baxley further discloses, that is "the gatekeeper selectively inserts one or more messages to the IVR (col. 8, lines 33-40 where it is suggested that the gatekeeper's request to the IVR is to insert one or more messages to the IVR)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the inserting of messages to the IVR with the method of claim 14 for  
10 the same reasons and motivation as in claim 14.

***Allowable Subject Matter***

Claims 12, 13, 17, 20, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all  
15 of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (703) 305-0342. The examiner can normally be reached on M-F: 8:30AM-5PM.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading  
Examiner  
Art Unit 2661

10 April 2, 2004



**KENNETH VANDERPUYE**  
**PRIMARY EXAMINER**